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AUG 01 2005

OFFICE OF PETITIONS

In re Application of :
Mikes and Xing : DECISION REFUSING STATUS
Application No. 10/685,270 : UNDER 37 CFR 1.47(a)
Filed: 14 October, 2003 :
Atty Docket No. 10004278-1 :

This is in response to the petition under 37 CFR 1.47(a) filed on 14 October, 2003.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 14 October, 2003, with a declaration naming Thomas L. Mikes and Lian Xing as joint inventors and signed by joint inventor Xing on behalf of himself and non-signing joint inventor Mikes. The present petition was also filed with the application.

Petitioners state that despite attempts to contact the non-signing inventor by E-mail and telephone, the non-signing inventor could not be reached to sign the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2).

In regards to item (1), petitioners have not shown that joint inventor Mikes was sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ Based on the showing of record, it does not appear that the specification, including claims, and the drawings, were among the application papers sent to the non-signing inventor.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

¹ MPEP 409.03(d).

With regards to item (2) the declaration is defective in that it does not state the residence, mailing address, or citizenship of non-signing inventor Mikes.² A statement of the inventor's citizenship is a statutory requirement and cannot be waived.³ A new oath or declaration, containing the residence, mailing address, and citizenship of both inventors, signed by the signing inventor on behalf of himself and the non-signing inventor in compliance with 37 CFR 1.63 and 1.67 is required.

Petitioners are reminded that any oath or declaration filed with a renewed petition must identify both the application number and filing date of the application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
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Office of Petitions

² MPEP 605.01.

³ 35 U.S.C. § 115, MPEP 605.01.